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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/595,837 | 09/20/2006 | Jiri Babej | 67562.56 | 7525 |
| 58785 | 7590 | 06/01/2009 | | |
| HUNTON & WILLIAMS/NEW YORK INTELLECTUAL PROPERTY DEPT. 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109 | | | | |
| | | | EXAMINER | |
| | | | SAETHER, FLEMMING | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3677 | |
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| | | | 06/01/2009 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/595,837 | BABEJ, JIRI | |
| | Examiner | Art Unit | |
| | Flemming Saether | 3677 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 18 February 2009.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 58-71,75-78 and 80-86 is/are pending in the application.
 4a) Of the above claim(s) 72-74,79 and 87-118 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 58-71,75-78 and 80-88 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 15 May 1006 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____ . |

Election/Restrictions

Applicant's election of group I. Species A in the reply filed on 2/18/2009 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Applicant indicated that claims 58-71, 75-78 and 80-86 read on the elected invention. Accordingly, claims 72-74, 79 and 87-118 withdrawn from further consideration pursuant to 37 CFR 1.142(b).

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the different options for the configuration of the element as claimed in claims 59 and 68 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 58-71, 75-78 and 80-86 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In each of the claims "ring-like" and "plate-like" is indefinite because it is unclear what would be considered as like a ring or a plate. All the dependent claims are indefinite because they all depend from claims which have been canceled and the intended dependency could not be determined because many of the claims would not make sense when being dependent from claim 58 which would have been the logical substitution for claim 1. A few examples are as follows: in claim 62, it is unclear how the recess can extend within the bead; in all of claims 80-84 it appears that "ribs" may be a double inclusion but that is uncertain since the dependency is incorrect; it appears that non-elected claims 72-74 and 79 would read on the elected species but, their intended dependency my not allow

for them to read on the elected species; in claim 81 it is unclear what the “noses” refers to, should it be --ribs--?; in claim 83 the ribs not extending beyond the ring-like contact surface appears to contradict what is shown in the drawings as seen in Fig. 1A.

Applicant should review all the dependent claims to not only correct their dependency but to ensure they make sense and also should reconsider which claims read on the elected species. Due to the confusion associated with the dependent claims no meaningful opinion can be made at this time as to how the prior art may be applicable to those claims but, the following rejection was made trying to incorporate many the features which were assumed would be included in the dependent claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 58 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller (US 6,125,524) in view of Persson (US 3,571,903). In the embodiment of Figs. 14-19, Mueller discloses a functional element for attachment to a plate-like component, the functional element comprising an internal thread (388); a hollow piercing section (216); a ring-like contact surface (230) perpendicular to the axis with a opposite pressing surface (not labeled), a ring groove (220) with a conical surface (see Fig. 16), ribs (222) provided in the ring groove do not extend beyond the ring groove (at 228) and include

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two sections (222 and 226) wherein the section 222 would be rectangular in cross-section; a ring-like contact surface (the end surface of section 216) and; a ring-like bead (not labeled but shown just below the groove 228 to define that groove) having a triangular cross-section. Mueller does not disclose the piercing section and the ring recess. Persson also discloses a functional element (10) for attachment to a plate-like component (11) but, Persson discloses a piercing section to include a ring-like cutting edge (17) between a cylindrical portion (16) and a free end (15) and also a U-shaped ring recess (20) between the free end and a ring-like bead (18). At the time the invention was made, it would have been obvious for one of ordinary skill in the art to provide the functional element of Mueller with a piercing section which includes a ring-like cutting edge between a cylindrical portion and a free end and also a U-shaped ring recess between the free end and the ring-like bead in order to facilitate the self piercing of the functional element into the plate as discussed in Persson.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Flemming Saether whose telephone number is 571-272-7071. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor Batson can be reached on 571-272-6987. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Flemming Saether
Primary Examiner
Art Unit 3677

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Primary Examiner, Art Unit 3677